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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,282	01/03/2003	Arnaud Fausse	09669/007001	3566

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,282

Applicant(s)

FAUSSE, ARNAUD

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010824</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

1. Claims 1-37 are pending.
2. The Preliminary Amendment filed 10/09/2001 has been received and considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite the limitation of "the data is decrypted systematically regardless of whether said data was originally encrypted or not." The specification does not make it clear to one of ordinary skill in the art how to perform this action. It is known in the art of encryption that one cannot decrypt

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information that is not encrypted. Therefore, this limitation lacks enablement in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16, 17, 29-31, 35 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 16, 29, 30, 35, and 37 recite the limitation "useful data" it is unknown what someone considers to be useful and each person may consider different data to be useful. Therefore, it is unclear what "useful data" defines.

8. Any claims not specifically addressed are rejected by virtue of their dependencies.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an

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application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5, 7-19, and 35 are rejected under 35

U.S.C. 102(e) as being anticipated by Edenson et al (US 6198875).

As per claims 1, 8, 18 and 19, Edenson et al discloses a disk, reading a disk and protecting data on a disk containing a decryption module comprising: a memory including at least one secret key (see column 3 lines 10-35); a cryptoprocessor to decrypt the data of said disk from said key (see column 5 lines 1-19); and a data exchange means for applying the data of said disk to the cryptoprocessor and reading the decrypted data of the cryptoprocessor (see figures 1 and 2 and column 3 lines 10-35 and column 5 lines 1-19).

As per claims 2-5 and 7, Edenson et al discloses the decryption module comprises a chip with an integrated circuit (see column 3 lines 10-35) the module and exchange means are integrated in a central zone of the disk and contain balancing means (see figure 1); and transmits with an energy field (see column 3 lines 3-9).

As per claims 9-10, Edenson et al discloses prior to the decryption stage, the data is modified into a format able to be

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understood by the cryptoprocessor by means of a cryptoprocessor interface included in an optical disk reader and computer (see column 3 lines 10-35 and column 5 lines 1-19 where it is inherent that the disk reader and computer can understand the data or the invention would not work).

As per claims 11-17 and 35, Edenson et al discloses loading both encrypted and decrypted data from different zones (see column 3 lines 10-35 and column 5 lines 1-19).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 6 and 20-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edenson et al (US 6198875) in view of Ludwig et al (DE 4242247).

As per claim 6, Edenson et al discloses the limitations of claim 1 as discussed above, but fails to disclose the data exchange means is fitted with contacts.

However, Ludwig et al teaches using contacts to exchange data (see page 4 and figure 1).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the contacts of Ludwig et al to exchange the data of Edenson et al.

Motivation to do so would have been to only allow an authorized person to read the data on the disk (see Ludwig et al page 3).

As per claims 20-22, the modified Edenson et al and Ludwig et al system discloses decrypting data of said disk with the aid of a secret key included in a memory of a portable object integrated in said disk with a chip and integrated circuit and remaining inside said object during decryption, exchanging the data of said disk between said portable object and said disk by means of data exchange means integrated in said disk (see Edenson et al column 3 lines 10-35 and column 5 lines 1-19); wherein the decryption state is carried out using a cryptoprocessor integrated in said portable object (see Ludwig et al pages 3-4).

As per claims 23-24, the modified Edenson et al and Ludwig et al system discloses prior to the decryption stage, the data is modified into a format able to be understood by the cryptoprocessor by means of a cryptoprocessor interface included

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in an optical disk reader and computer (see Edenson et al column 3 lines 10-35 and column 5 lines 1-19 where it is inherent that the disk reader and computer can understand the data or the invention would not work).

As per claims 25-34 and 36-37, the modified Edenson et al and Ludwig et al system discloses loading both encrypted and decrypted data from different zones (see Edenson et al column 3 lines 10-35 and column 5 lines 1-19 and Ludwig et al pages 3-4).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Markandey et al (US 6526144) and Nerlikar et al (US 5905798) each teach methods of controlling information on a disk using a chip in the central zone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER